

The Office Action asserts that Sano describes each element of the claimed invention except that its toner comprises a volume percentage of particles having a particle size of 5.04 μm or less or that the releasant dispersed in the binder resin has an average particle size as recited in the claims. The Office Action further asserts that using toner comprising a volume percentage of particles having a particle size of 5.04 μm would have been obvious in view of the teachings of Sano. Moreover, the Office Action asserts that Kumashiro describes a releasant dispersed in a binder resin that has an average particle size as recited in the claims. The Office Action thus concludes that the combination of Sano and Kumashiro renders the claimed invention obvious to those of ordinary skill in the art.

Independent claim 1 concerns a toner for electrophotography. The toner includes a wax and a colorant dispersed in and thereby mixed with a binder resin. The average diameter of the wax in the binder resin is in a range from 0.1 to 3.0 μm . Moreover, the toner contains 1.0 to 2.5 % by volume of a toner with particle diameters of 5.04 μm or smaller. Applicants have found that their composition of toner containing 1.0 to 2.5 % by volume of toner particles having diameters of 5.04 μm or smaller with wax having an average diameter in a range from 0.1 to 3.0 μm results in a grinding affect which will prevent a phenomenon known as filming. In particular, Applicants' toner composition having the recited percentage by volume of toner particles of 5.04 μm or less and a wax having average diameters from 0.1 to 3.0 μm makes it possible to grind, at an early stage, toner components that have attached to a photoconductor. According to Applicants, this reliably prevents filming. Moreover, Applicants advise, their composition also prevents another phenomenon known as hot offsetting. Obtaining this grinding property while preventing filming and hot offsetting are superior results achieved by Applicants with their claimed toner composition.

Sano discloses a conditional formula prescribing the relationship between the average toner diameter and the proportion of toner particles of 5 μm or less for the purpose of obtaining satisfactory charge stability with the toner. Hence, the objectives and results of the invention described by Sano are completely different from Applicants' invention. Sano neither teaches nor suggests the superior grinding and preventative affects (no filming or hot offsetting) obtained by Applicants' claimed toner composition.

As conceded in the Office Action, Sano also fails to teach or fairly suggest a toner wherein the average diameter of the wax in the binder resin is in a range from 0.1 to 3.0 μm . The Office Action thus turns to Kumashiro as teaching this feature of the claimed invention. Kumashiro discloses employing wax particles having an average diameter of 0.1 to 1.5 μm . However, Kumashiro can not be relied upon to remedy the deficiencies of Sano without improper use of hindsight.

Neither Sano nor Kumashiro recognizes the problem that Applicants have solved with their claimed composition. Neither cited document sets limits on both toner particle diameter and wax diameter, as set forth in claim 1, in order to achieve early stage grinding and thereby eliminate filming. Thus, neither document provides the requisite motivation to those of ordinary skill in the art to combine the teachings of these two documents as asserted by the Office Action. Indeed, neither Sano nor Kumashiro even recognizes the grinding affect provided by the toner particles of the claimed invention, let alone that such affect when applied in the presence of wax particles of Applicants' claimed size range, would prevent filming. Hence, there is no motivation provided by either cited document to combine the teachings of the two documents in such a way as to achieve the Applicants' superior results and thereby render the present claims obvious.

To establish a *prima facie* case of obviousness, the Examiner must provide factual support from the cited patent for the proposed modification. This factual support must be

based on objective evidence of record and must establish that the cited patent itself provides the requisite motivation, suggestion, or teaching regarding the desirability of making the specific combination made by the Applicant. The factual question of motivation is material to patentability, and can not be resolved on subjective belief and unknown authority. It is improper to determine whether a person of ordinary skill would have been led to modify the prior art based upon hindsight. In re Sang Su Lee, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). Applicants submit that given the teachings of the two cited prior art documents and the lack of motivation provided by the two documents to combine the teachings of the two document as suggested by the Office Action, the present rejection untenably is based on improper use of hindsight and must be withdrawn.

The above remarks overcome this rejection. Thus, reconsideration and withdrawal of the rejection are respectfully requested.

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Claims 1-6 and 8 are rejected under 35 U.S.C. § 103(a) as purportedly obvious based on Asada (U.S. Pat. No. 5,976,754) in view of Sano.

Claim 7 is rejected under 35 U.S.C. § 103(a) as purportedly obvious based on Asada in view of Sano, and further in view of additional teachings of Asada. These two rejections are addressed together as similar issues apply to both. Applicants respectfully traverse both rejections.

For similar reasons as discussed above, there also is no motivation provided by Asada or Sano to combine their teachings in any manner rendering the present claims obvious. Asada discloses a toner containing a compatibilizing agent for compatibilizing a binder resin and a releasant wherein the diameter of dispersed wax particles ranges from 0.2 to 1.5 μm . However, as with Kumashiro, Asada also can not remedy the deficiency of Sano as to the grinding affect achieved by Applicants' toner composition to prevent

filming. Hence, there is no suggestion to combine Asada or Sano as asserted by the Office Action other than through hindsight gained from review of the Applicants' own disclosure. Thus, these two rejections are also respectfully submitted as untenable based on improper hindsight.

The above remarks overcome both of these rejections. Thus, reconsideration and withdrawal of both rejections are respectfully requested.

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Applicants respectfully submit that this Request for Reconsideration and the above remarks obviate the outstanding rejections in this case, thereby placing the application in condition for immediate allowance. Allowance of this application is earnestly solicited.

If any fees under 37 C.F.R. §§1.16 or 1.17 are due in connection with this filing, please charge the fees to Deposit Account No. 02-4300; Order No. 032739.072.

If an extension of time under 37 C.F.R. § 1.136 is necessary that is not accounted for in the papers filed herewith, such an extension is requested. The extension fee should be charged to Deposit Account No. 02-4300; Order No. 032739.072.

Respectfully submitted,
SMITH, GAMBRELL & RUSSELL, LLP

By:



Michael A. Makuch, Reg. No. 32,263
1850 M Street, N.W., Suite 800
Washington, D.C. 20036
Telephone: (202) 263-4300
Facsimile: (202) 263-4329

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MAM/BLN